REMARKS

In the September 23, 2004 Office Action, the Examiner noted that claims 14-25 were pending in the application; objected to the drawings and Abstract; rejected claims 14-24 under the second paragraph of 35 U.S.C. § 112; and rejected claims 14-25 under 35 U.S.C. §102(e) as anticipated by U.S. Patent 6,282,701 to Wygodny et al. Claim 17 has been cancelled and thus, claims 14-16 and 18-25 remain in the case. The Examiner's rejections are traversed below.

The Application

The application is directed to instrumentation in program code for monitoring of a program distributed throughout a system. As described in paragraph [0009] of the Substitute Specification, it is particularly advantageous for use in monitoring "middleware" which is increasingly used as programs become more modular and program code is obtained from many sources.

The Prior Art: U.S. Patent 6,282,701 to Wygodny et al.

The Wygodny et al. patent is directed to monitoring and analyzing the execution of computer programs, each of which may contain multiple threads and multiple processes, using a trace function by embedding tracing code in the source code.

Objection to Drawings

In item 4 on pages 2-3 of the Office Action, the Examiner required drawings with legends in English. The Examiner's attention is directed to the English translation filed on September 12, 2001 which included translations of all of the German words in the international application. Attached hereto are Replacement Sheets containing the drawings included in the English translation. Withdrawal of the rejection is respectfully requested.

Objection to Abstract

In items 5 and 6 on pages 3-4 of the Office Action, the Examiner objected to the Abstract due to the use of a title different than that used on the first page of the Substitute Specification and because the "Abstract does not contain sufficient and concise statements of the disclosure of the instant application." A Substitute Abstract is submitted herewith with the title corrected. In addition, the wording of the Abstract has been changed to reflect the changes made to claim 14. However, it is unclear what "sufficient and concise statements" the Examiner wants to see in the

7

Abstract. The Examiner is respectfully requested to contact the undersigned by telephone to explain this requirement or provide further explanation in the next Office Action, if the Substitute Abstract is insufficient.

Rejections under 35 U.S.C. § 112, Second Paragraph

In item 8 on pages 4-5 of the Office Action, claims 14-24 were rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness. Claims 14, 15, 23 and 24 have been amended in response to this rejection. Withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

In item 10 on pages 6-10 of the Office Action, claims 14-25 were rejected under 35 U.S.C. § 102(e) as anticipated by Wygodny et al. The independent claims 14 and 23-25 have been amended to incorporate the limitations of claim 20 which has been cancelled. Therefore the rejection of claim 20 will be addressed below.

In rejecting claim 20, column 7, lines 10-23 of Wygodny et al. was cited as disclosing the instrumentation of middleware. This portion of Wygodny et al. states that the "developer 112 uses the analyzer 106 to interactively create trace control information (TCI)" (column 7, lines 12-13). As illustrated in Fig. 1A the developer 112 is a person and therefore, is irrelevant to the claims. It is also stated in this portion of Wygodny et al. that the "TCI may be sent to the client-side trace library 125 via file input/output operations or through conventional inter-process communication mechanisms such as shared memory, message passing, or remote procedure calls" (column 7, lines13-17). Thus, the language cited in Wygodny et al. as supporting the rejection of claim 17 relates to how trace information is communicated, not what types of operations are traced.

Nothing has been cited or found in Wygodny et al. that program code can or should be inserted into a program to monitor "middleware associated with the program" (e.g., claim 14, lines 4-5), as opposed to monitoring the program in which an instrumentation part has been added. The present invention provides numerous benefits, some of which are described in paragraph [0009] of the Substitute Specification. Utilization of the invention can reduce the amount of instrumentation code required and more easily (compared to prior art methods) limit monitoring to code that is of particular interest. In addition, changes in the instrumentation can take place centrally at one place for all routines concerned and if the middleware to be monitored is changed, the instrumentation part remains, so that the revised middleware can still

be monitored without adding instrumentation code to it. None of these benefits are taught or suggested by <u>Wygodny et al.</u>

Supplemental Information Disclosure Statement

In item 3 of the September 23, 2004 Office Action, the Examiner indicated that German Patent Application 4323787 A1 included in the Information Disclosure Statement filed September 12, 2001 was not considered, despite the explanation of relevance provided. Therefore, submitted herewith is an English translation of the claims in German Patent Application 4323787 A1 from corresponding European Patent Application 708941 B1. Consideration of German Patent Application 4323787 A1 is respectfully requested.

Summary

For the above reasons it is submitted that claims 14-16 and 18-25 patentably distinguish over <u>Wygodny et al.</u> Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 12/23/04   By: _Richard A. Bollhofer_
                         Richard A. Gollhofer
                         Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

AMENDMENTS TO THE DRAWINGS:

In the Office Action at item 4, the Examiner objected to the drawings. To overcome these objections, replacement figures are submitted herewith containing English legends identical to those in the drawings of the English translation filed September 12, 2001. Approval of these changes to the Drawings is respectfully requested.